REMARKS

Claims 1-17 are pending in the application.

The paragraph bridging pages 5-6 of the specification has been amended. Support for this amendment can be found in paragraph [008] of the priority document, JP 2002-315649, the disclosure of which is incorporated by reference near the top of page 1 of the present application (a sworn English translation of paragraph [008] is submitted herewith).

Claim 1 has been amended to recite "an inorganic nonmagnetic substrate." Support for this amendment can be found, for example, on page 28, lines 13-16 of the specification.

Claim 4 has been amended to recite "edge" rather than "end surface." Support for this amendment can be found in the paragraph bridging pages 5 to 6 of the specification (amended herein).

Claims 16 and 17 have been added. Support for the new claims can be found on page 8, lines 20-21 of the specification, with claim 16 being based on the preferred lower limit for thickness and the more preferred upper limit for thickness.

Claims 2-5, 8 and 11-15 have been amended to depend from new claim 16.

Claim 5 is objected to for informalities.

The Examiner asserts that "conducive" in claim 5 should be "conductive."

Applicants have amended as suggested by the Examiner. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

Claim 4 has been rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite.

As stated above, Applicants have amended claim 4 to recite "edge" rather than "end surface." Applicants submit that claim 4 is clear and definite and respectfully request that the Examiner reconsider and withdraw the rejection.

Claims 1-10, 12 and 14-15 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Saitoh et al., U.S. Patent No. 6,127,039, in view of Murray et al., U.S. Patent No. 6,254,662.

Claims 1, 3-4 and 11 have been rejected under 35 U.S.C. § 103(a) over Yanai et al., JP 04005212 in view of Murray et al.

Claim 13 has been rejected under 35 U.S.C. § 103 over Saitoh as modified by Murray, and further in view of Ushigome, U.S. Patent No. 5,523,153.

The Examiner asserts that it would be obvious to one of ordinary skill in the art to substitute the FePt CuAu type particles of Murray for the Fe based magnetic particles of Saitoh and Yanai to produce Applicants ' claimed invention.

Claim 1 is directed to:

> A magnetic recording medium comprising a magnetic layer on at least one side of an inorganic nonmagnetic substrate, the magnetic layer containing magnetic particles of a CuAu type or Cu_3Au type ferromagnetic ordered phase, wherein a conductive layer is provided on at least one side of the inorganic nonmagnetic substrate.

Applicants submit that Saitoh, Yanai, and Ushigome use an organic substrate, as disclosed in column 15, lines 13-26 of Saitoh, Example 1 in Yanai, and col. 5, line 2 in Ushigome. The upper temperature limit of the organic substrates is about 400 °C. However, in

order to convert the FePt alloy disclosed in Murray to a ferromagnetic substance usable in a magnetic recording medium which substance should have a Hc of at least 1000 Oe, it is necessary to anneal the alloy at a temperature of at least 500 °C after the alloy is coated on the substrate. Therefore, Applicants submit that it is impossible to use the FePt alloy disclosed in Murray in the media disclosed in Saitoh, Yanai, and Ushigome. Accordingly, the invention disclosed in claim 1, as amended, is not obvious over the combination of Saitoh, Yanai, Ushigome and Murray.

Additionally, Applicants have added dependent claim 16, which recites that the conductive layer is 10 to 400 nm. Applicants have amended claims 2-5, 8 and 11-15 to depend from claim 16. In column 16, lines 53-56 of Saitoh, it is recited that "The non-magnetic layer has generally a thickness of 0.5 to 3.0 μm. Preferably, the non-magnetic layer has a thickness of at least 0.8 μm in order to ensure the advantages of providing the non-magnetic layer." In Example 1 of Yanai, the dry thickness of the backcoat is 1 μm. Therefore, the disclosure of Saitoh and Yanai teaches away from the 20 to 400 nm (0.02 to 0.4 μm) range of Applicants' claim 16.

Further, Applicants' claim 4 recites, "the conductive layer is disposed on an edge of the inorganic nonmagnetic substrate." Applicants submit that the medium of Saitoh is formed by slitting, as recited in column 18, lines 32-33. Therefore, the medium in Saitoh does not have a conductive layer on the edge of the substrate. The backcoat of Yanai is provided on the surface that is on the opposite side of the substrate from the magnetic layer, as is clear from claim 1 of Yanai. Therefore, Yanai does not have a conductive layer on the edge of the substrate.

In view of the above, Applicants submit that the presently claimed invention is not obvious over Saitoh or Yanai in view of Murray or over Saitoh and Murray further in view of Ushigome. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejections.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

Jennifer Leach

Jennifer R. Leach
Registration No. 54,257

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

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